

The opinion in support of the decision being entered today
is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STEVEN M. LANDAU

Appeal 2007-0312
Application 10/090,574
Technology Center 1600

Decided: June 19, 2007

Before DEMETRA J. MILLS, ERIC GRIMES, and NANCY J. LINCK,
Administrative Patent Judges.

LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals the Examiner's two 35 U.S.C. § 103(a) rejections of claims 1-17 in the above-referenced application, entitled "System and Method of Administering Pharmaceuticals and Nutraceuticals as Part of a Beverage Container." (Specification ("Spec.") 1.)

We have jurisdiction to decide this appeal under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

“The present invention relates to beverages and liquids, such as cough syrup, sports drinks, and diet supplement drinks, that contain either pharmaceuticals and/or nutraceuticals.” (Spec. 1.) More particularly, the presently claimed invention is a “method for providing a dry consumable with a liquid in the same assembly. The assembly includes a fluid container that is covered with a cap assembly. The cap assembly can be manually opened and closed, thereby selectively controlling the flow of fluid out of the fluid container. Consumable material is disposed in a solid form on the exterior of the cap assembly.” (*Id.* at 4.) Preferably, the material is “insoluble in liquid.” (*Id.* at 8.) “Once the consumable material is taken into the mouth, liquid can be drunk through the cap assembly to help wash the consumable material down the throat.” (*Id.* at 5.) “The material is formed into a solid formation that can be bitten or licked away from the cap assembly as the cap assembly is placed in the mouth. As such, the present invention provides a single assembly where a person can consume a dry product and be provided with liquid to help swallow that dry product.” (*Id.* at 5.)

The claimed subject matter is reflected in representative claims 1 and 12, the only independent claims before us:

1. A method of administering a biologically beneficial compound, comprising the steps of:

providing a beverage container having a cap assembly through which liquid in said beverage container is drunk, wherein said cap assembly has at least one exterior surface that passes into a drinker's mouth when said liquid is drunk through said cap assembly;

forming a mass of a biologically beneficial compound on said at least one exterior surface of said cap assembly, wherein said mass of biologically beneficial compound passes into the mouth of a person drinking from said beverage container through said cap assembly.

12. A method, comprising the steps of:

providing a bottle containing a consumable liquid;

providing a cap assembly for said bottle, wherein said cap assembly has at least one exterior surface, and wherein said cap assembly can be selectively opened and said consumable liquid drunk from said bottle through said cap assembly;

providing a consumable material on said at least one exterior surface of said cap assembly, wherein said consumable material passes into the mouth when said consumable liquid is drunk directly from said cap assembly.

The Examiner's two 35 U.S.C. § 103(a) rejections of claims 1-17 are based on each of the following patents:¹

Johnson	US 5,456,351	Oct. 10, 1995
Schoo	US 6,527,109 B2	Mar. 4, 2003

ISSUES ON APPEAL

With respect to both § 103(a) rejections, Appellant contends neither of the references discloses or suggests the steps of: (1) "forming a mass of a biologically beneficial compound [or providing consumable material] on an exterior surface [of] the cap assembly;" and (2) "having the mass of biologically beneficial compound [or consumable material] pass into the mouth of a person drinking with the cap assembly." (Br. 5-8.)

¹ The dates in the table are issue dates.

With respect to the § 103 rejection based on Johnson, Appellant additionally contends this reference does not disclose or suggest the steps of: (3) “providing a beverage container [or bottle] having a cap assembly through which liquid . . . is drunk;” and (4) “providing a cap assembly having at least one exterior surface that passes into a drinker’s mouth when liquid is drunk through the cap assembly.” (Br. 6.)

With respect to Johnson, the Examiner admits Johnson “does not teach . . . a cap assembly for a bottle” (Answer 6), drinking “through said cap assembly” (*id.* at 7), or “a mass of beneficial compound . . . on the exterior surface” of the cap (*id.* at 8). However, the Examiner is not convinced by Appellant’s arguments because the “cap assembly claimed and the two-part lid taught by Johnson are functionally equivalent in structure and are employed for the same purpose.” (*Id.* at 7.) In other words, “Johnson teaches the same generic concept and objective of providing for a first constituent that is in solid [form] and separated from the second constituent.” (*Id.* at 8.) According to the Examiner: “The prior art explicitly desires consumption of a solid material, such as pharmaceuticals, in combination with liquid constituents. Thus, no unexpected and/or superior results are attributed through Appellant’s incorporation of a solid mass on the ‘exterior’ surface of the cap assembly versus the prior art’s incorporation of a solid mass on the interior surface of the container.” (*Id.* at 9.) Additionally, according to the Examiner, “Applicant’s claim limitation of ‘when said liquid is drunk through said cap assembly’ is a future intended use limitation, which affords no patentable weight.” (*Id.* at 7.)

With respect to Schoo, the Examiner admits that Schoo's "biologically beneficial material" is "on the interior surface of the cap" but argues "the container cap with liquid dissolvable additive of Schoo is structurally equivalent to the beverage container instantly claimed." (*Id.* at 14.) Again, the Examiner posits the limitation requiring the "biologically beneficial compound" or "consumable material" to "pass[] into the mouth of a person drinking from said beverage container through said cap assembly" is a "future-intended use limitation, which affords no patentable weight." (*Id.* at 16.)

With these contentions before us, we frame the issue as follows:

Would Appellant's claimed invention have been obvious at the time the invention was made, including the limitation "forming a mass of a biologically beneficial compound [or providing a consumable material] on said at least one exterior surface of said cap assembly, wherein said mass of biologically beneficial compound passes into the mouth of a person drinking from said beverage container through said cap assembly," based either on the teachings of Johnson or Schoo?

FINDINGS OF FACT²

The Claims

Giving claims 1 and 12 their broadest reasonable interpretation:

1. Appellant's claimed process requires providing a "bottle" or "beverage container" and a "cap assembly"; forming or providing "a mass of beneficial compound [or consumable material] on the exterior surface" of

² Findings of Fact are abbreviated "FF."

the cap; and providing the capability of “drinking through said cap assembly.” (Claims 1 & 12.)

2. Appellant’s claimed process requires that it permit the “at least one exterior surface” to pass into “a drinker’s mouth when said liquid is drunk through said cap assembly” (claim 1) or permit the “consumable material” to pass into “the mouth when said consumable liquid is drunk directly from said cap assembly” (claim 12).

3. Appellant’s claimed placement of his consumable material addresses the problem of getting the material into the mouth when the material is liquid insoluble by biting or licking it. (*See* Spec. 8-9 (describing liquid-insoluble materials as preferred).)

Findings Based On Johnson

4. Johnson does not disclose “a cap assembly for a bottle” (Answer 6), drinking “through said cap assembly” (*id.* at 7), or “a mass of beneficial compound . . . on the exterior surface” of a cap (*id.* at 8).

5. Johnson shares Appellant’s goal to provide a “method of delivering a substance with two constituent parts that may be required to be separated until just prior to use” (Johnson, col. 1, ll. 17-19), but uses different means to accomplish that goal, i.e., a cup for one constituent (e.g., wine for communion) and a two-part peelable lid for a second constituent (e.g., a wafer for communion). (*See, e.g., id.* at col. 3, ll. 30-51.)

6. Johnson would not have provided a reason or suggestion to modify Johnson’s cup and lid to facilitate drinking through the lid or depositing a solid on its exterior surface such that the solid “passes into the mouth of a person drinking from” the cup through the lid. (*See* Johnson *passim*.)

Findings Based On Schoo

7. Schoo discloses a “beverage container [or bottle] having a cap assembly through which liquid in said beverage container is drunk” (claim 1). (*See* Schoo, Figs. 12, 13 & 15 (Appendix) (disclosing a bottle and cap assembly, including a “sport-cap . . . having a part that can be displaced axially to open and close the cap.”) (Schoo, col. 5, ll. 8-16).)

8. Schoo also discloses a “liquid-dissolvable body,” which can be an additive such as fluoride, vitamins, flavoring, etc.” (Schoo, col. 1, ll. 54-65.)

9. “When the cap is mounted on a liquid container, such as by screwing it onto a conventional water bottle, the water in the bottle dissolves the liquid-dissolvable body.” (Schoo, col. 1, ll. 60-63.)

10. Schoo’s cap assembly, when the “sport-cap” is included, “can be selectively opened and said consumable liquid [can be] drunk from said bottle through said cap assembly,” as required by claim 12. (*See* Schoo, col. 5, ll. 8-16; FFs 7 & 9.)

11. Further, “when said liquid is drunk through said cap assembly” (claim 1), at least some of the surface of Schoo’s “liquid-dissolvable body” (disk 30), i.e., a biologically beneficial compound (disk 30) “passes into [the] drinker’s mouth.” (FFs 9 & 10.)

12. However, Schoo does not disclose or suggest incorporating a liquid-insoluble body in cap 10. (*See* Schoo *passim*.)

13. Further, as the Examiner admits, Schoo’s consumable material (disk 30 or 330) is on the interior surface Schoo’s cap (10 or 310) and, thus, would not come in contact with the mouth to permit it to be bitten or licked. (*See* Figs. 3, 14 & 15.)

14. Schoo's cap is designed to permit his liquid-dissolvable material (disk 30) inside the cap (10) to at least partially dissolve when it is exposed to a liquid in Schoo's beverage container (60), either by shaking or inverting (*see, e.g.*, Schoo, col. 1, ll. 54-65), and thus Schoo's liquid-dissolvable material must necessarily be on the inside surface of Schoo's cap (10).

15. One of ordinary skill in the art would not have had any reason to place Schoo's liquid-dissolvable material (disk 30) on the exterior surface of Schoo's cap (10), as the purpose of Schoo's design would have been defeated, i.e., the liquid-dissolvable material (disk 30) would not have dissolved when the liquid in the beverage container (60) was shaken or inverted.

16. Furthermore, Schoo's liquid-dissolvable material does not require that it be bitten or licked, as is the case with Appellant's material when it is liquid-insoluble (FF 3), and thus one skilled in art would not have had any reason to move Schoo's liquid-dissolvable material (disk 30) to an exterior surface of Schoo's cap (10).

DISCUSSION

The § 103 Rejection Based On Johnson

As found and admitted by the Examiner, Johnson does not disclose "a cap assembly for a bottle," drinking "through said cap assembly," or "a mass of beneficial compound . . . on the exterior surface" of a cap. (See FF 4.) The fact that Johnson shares one of Appellant's goals, i.e., to provide a "method of delivering a substance with two constituent parts that may be required to be separated until just prior to use" (FF 5), is not sufficient to

support a prima facie case of unpatentability under § 103. If it were, few inventions made to address a common problem would be patentable.

Given Johnson's described embodiments and uses, there would have been no reason or suggestion to modify Johnson's cup and lid to provide drinking through the lid "wherein" the solid "passes into the mouth of a person drinking from" the cup through the lid. (FF 6.) We agree with the Examiner that the "wherein" clause is a "future intended use limitation" (*id.* at 7). *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) ("a whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited"). However, when such a clause "states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005) (quoting *Minton*). Thus, the process shown in the prior art must be able to provide the intended result. Johnson, or obvious modifications of Johnson, would not appear to do so.

The Examiner argues Appellant has not shown "unexpected and/or superior results." (Answer 9.) As the Examiner has not made a prima facie case of obviousness under § 103 based on Johnson, the burden did not shift to Appellant to show such results.

For these reasons, we reverse the Examiner's § 103 rejection based on Johnson.

The § 103 Rejection Based on Schoo

Unlike Johnson, Schoo discloses a “beverage container having a cap assembly through which liquid in said beverage container is drunk.” (FFs 7 & 10.) Further, “when said liquid is drunk through said cap assembly,” at least some of Schoo’s “liquid-dissolvable body” passes into the drinker’s mouth. (FFs 8, 9, & 11.)

However, Schoo does not disclose “a mass of biologically beneficial material” or “consumable material” on an “exterior surface” of the cap. (FF 13.) Further, the skilled artisan considering modifications to Schoo’s design would not have had any reason to place Schoo’s liquid-dissolvable material on the exterior surface of Schoo’s cap for at least two reasons: First, Schoo’s beverage container and cap assembly would not have functioned as Schoo intended (FF 14 & 15); and second, Schoo’s consumable material does not need to be bitten or licked to get it into the mouth, as Schoo’s teachings require it to be a liquid-dissolvable material (FF 12 & 16). In contrast, when Appellant’s material is liquid insoluble (Appellant’s preferred embodiment), its claimed placement permits it to be bitten or licked when taken into the mouth. (FF 3 & 16.)

Based on the above findings and reasoning, we conclude Schoo would not have suggested Appellant’s claimed method, given Schoo’s reason for placing the liquid-dissolvable material on the interior of the cap. Thus, we reverse the § 103 rejection based on Schoo of claims 1 and 12. Given all the remaining claims before us are dependent on claim 1 or 12, we also reverse the Examiner’s rejection of those claims.

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CONCLUSION

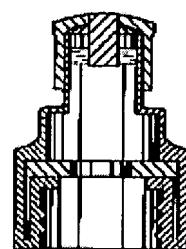
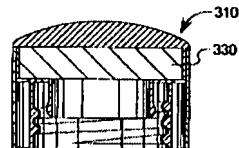
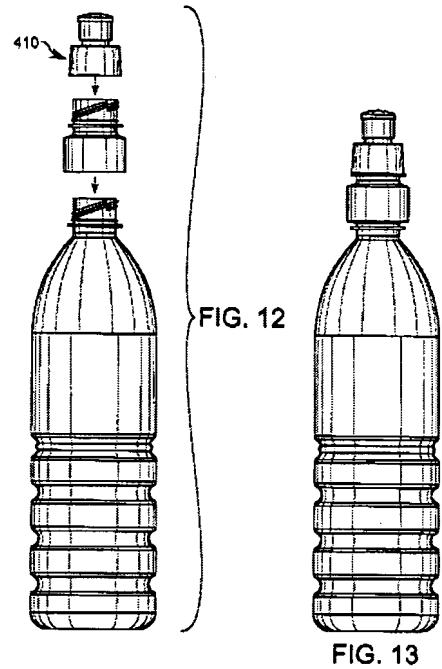
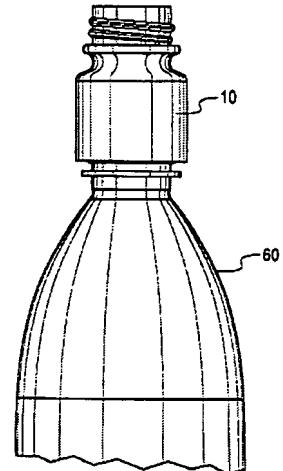
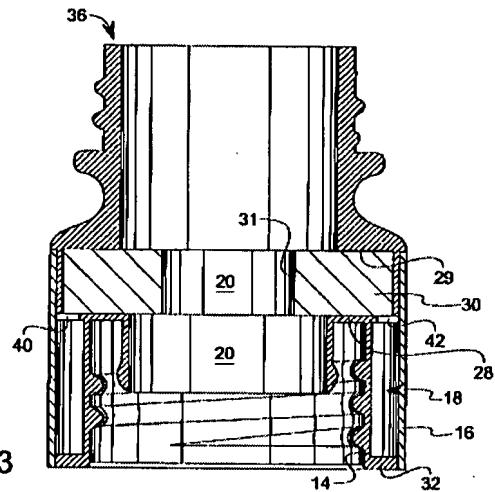
We reverse both of the § 103(a) rejections of claims 1-17.

REVERSED

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APPENDIX



U.S. Patent No. 6,527,109